

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Final Office Action of July 12, 2007 (Office Action). The response is timely filed within the 3 month shortened statutory period, and, as such, no fee is believed due. However, the Office is expressly authorized to charge any deficiencies or credit any overpayments to Deposit Account 50-0951.

In the Office Action, Claims 1, 2, 4-15, and 17-22 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 2, 5-9, 11-15, and 18-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2002/0052935 to Paxhia et al. (hereinafter Paxhia) in view of U.S. Patent Publication No. 2003/0055863 to Spiegel et al. (hereinafter Speigel). Claims 4, 10, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Paxhia in view of Spiegel and further in view of U.S. Patent No. 5,778,387 to Wilkerson (hereinafter Wilkerson).

#### **Rejections Under §112**

Although Applicants respectfully disagree with the rejections asserted in the Office Action, Applicants nonetheless have amended some of the claims in order to expedite prosecution by further emphasizing certain aspects of the claims. However, Applicants respectfully assert that any amendment and/or cancellation of claims in this response should not be interpreted as the surrender of any subject matter. Thus, Applicants are not conceding by these amendments and cancellations that any previously submitted claims are not patentable over the references of record. Applicants' present claim amendments and cancellations are only submitted for purposes of facilitating expeditious prosecution of the present Application. Accordingly, Applicants reserve the right to pursue any previously submitted claims in one or more continuation and/or divisional patent applications.

In the Office Action, the claims were rejected to as being indefinite. In particular, the Office Action asserts that the term "z/Architecture" is not sufficiently descriptive to enable one of ordinary skill in the art to practice the invention and that it only refers to a

trademark. Although Applicants respectfully disagree with the rejection in the Office Action, Applicants have nonetheless amended the claims to expedite prosecution. In particular, the limitation "z/Architecture" has been replaced with the limitation "computer architecture for supporting multiple operating systems and applications using one or mode different addressing modes". Although such a limitation is not explicitly stated in the Specification, Applicants respectfully submit that one of ordinary skill in the art would recognize that the characteristic feature of zSeries® computers using z/Architecture™, as recited in the Specification, is that they have a specific computer architecture that can support concurrent operation of operating systems and applications, even if they use different addressing modes.

**Applicants' Invention Predates the Publication Date of Spiegel**  
**and was Commonly Owned by IBM Corporation**

In the Office Action, the claims were rejected as being unpatentable under Paxhia in view of Spiegel. Applicants respectfully submit, however, that any rejection based on Spiegel, alone or in combination with any other reference or record, is moot because Spiegel and Applicants' invention were commonly owned.

Applicants conceived of their invention at least as early as April 30, 2004 and actively pursued its reduction to practice from a date prior to the publication date of Spiegel. In support of the assertion, Applicants submit the Declarations attached hereto in accordance with 37 CFR § 1.131. The Declarations establish conception and continuing diligence from a time prior to the publication date of Spiegel to the filing of the Application.

Along with the Declaration, Applicants also submit herewith, as Exhibit "A," a copy of Confidential Invention Disclosure No. BOC8-2002-0123, titled *GUI Interface to configure TCP/IP on a Z series operating system* (hereinafter Disclosure). The Disclosure was submitted on December 3, 2002, by Applicants to an intellectual property (IP) professional employed by the assignee of Applicants' invention and the Spiegel

reference, International Business Machines Corporation (IBM). The Disclosure was insubstantially modified on December 9, 2002. The description of the invention itself, however, was not modified after the Disclosure was initially submitted. Indeed, as noted below, established IBM procedures for handling all such disclosures preclude any modification to the description of the invention once it has been submitted by an inventor. The Disclosure has not been revised subsequent to December 9, 2002.

The Disclosure explicitly describes Applicants' invention. The written description provided in the Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as December 3, 2002.

The Disclosure is an IBM confidential disclosure form. As such, it is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional.

The written description and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the Applicants reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Applicants exercised due diligence from a date prior to the publication date of Spiegel to the date that the Application was filed. As expressly affirmed in the Declaration, Applicants from at least December 3, 2002, through the filing of the Application on September 23, 2003, worked diligently toward a constructive reduction to practice of the invention. Applicants initially worked with IBM's own in-house IP

professionals during an internal review of the invention, including assessing the invention in the context of related literature. Subsequently, Applicants worked with outside counsel retained by IBM to prepare and file the Application.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with bar dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

Evidence of Applicants' due diligence is submitted herewith in the form of various documents. Exhibit "B" is a professional search report dated as received on January 8, 2003, prepared by an outside consultant and conducted prior to IBM's requesting that outside counsel prepare the Application. Exhibit "B" is stamped as having been received by in-house counsel at Applicants' location on January 9, 2003. Exhibit "C" includes a copy of a report from Inventor Golden, dated March 20, 2003, responding to results of the search report. Exhibit "D" is a letter from IBM counsel requesting that outside counsel prepare the Application, the letter being dated March 26, 2003. Exhibit "E" is a March 27, 2003, letter from outside counsel to IBM counsel confirming receipt of the instructions. Exhibit "F" is a series of email communications occurring between September 5, 2003 and September 16, 2003 regarding Applicants' review and approval of the Application drafted by outside counsel. Final approval of the Application is evidenced by Applicants' signatures dated September 16, 2003, on the signature page for Declaration and Power of Attorney filed with the Application (a copy is included in this response for convenience as Exhibit "G").

Applicants respectfully submit that it was reasonable for Applicants to rely on outside counsel in preparing the Application, and that outside counsel acted with diligence, notwithstanding the constraints of other work obligations, in preparing the Application. Applicants further respectfully submit that the evidence of specific activity

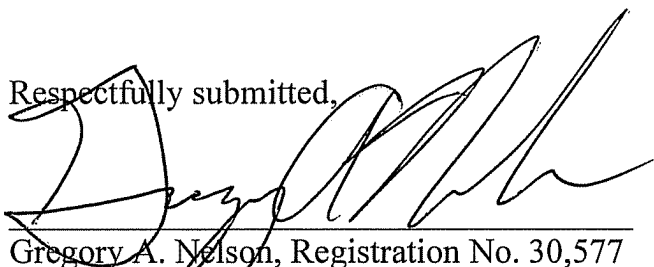
on specific dates clearly evidences Applicants' prior conception and diligence in pursuing a reduction to practice from a time prior to the publication date of Spiegel.

Therefore, in view that Applicants' invention predates the publication date of Spiegel, Applicants respectfully submit that Spiegel cannot be cited as a § 103(a) reference qualifying under § 102(a), but rather only as a § 103(a) reference qualifying under § 102(e). Accordingly, because the subject matter of Spiegel and the present Application were commonly owned by the same entity, International Business Machines Corporation (IBM), at the time the claimed invention was made, Applicants respectfully submit that 35 U.S.C. § 103(c) precludes citing Spiegel, a reference qualifying only under § 102(e), against the present Application. Applicants therefore respectfully submit that the rejections under Spiegel be withdrawn.

### CONCLUSION

Applicants respectfully requests that the Examiner call the undersigned if it is believed that the above restriction election is incomplete or in any way improper. Applicants also requests that the Examiner call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the above-identified application to an allowance.

Respectfully submitted,



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